

REMARKS/ARGUMENTS

Claims 6 through 9, 11, 13 through 17, and 31 through 44 are rejected as unpatentable over Hampton et al. US Patent 5,089,270, and Claims 18 through 20 and 45 through 47 are rejected as unpatentable over Hampton in view of Hoover et al. US Patent 5,464,631. Applicant presents remarks below that clearly demonstrate the patentability of the recited claims over Hampton and the combination of Hampton and Hoover. Claim objections and a new matter rejection are also addressed below. Accordingly, Claims 6 through 9, 11, and 13 through 20, and 31 through 47 remain pending after entry of this Amendment.

Several dependent Claims are objected to because they have been renumbered during prosecution to depend from claims that follow them rather than claims that precede them in numerical order. This was done after the cancellation of independent Claim 1 in order to avoid canceling and re-entering a multitude of dependent claims. MPEP 608.01(n)IV recognizes that the order of claims may change during prosecution to be in conflict with claim arrangement requirements, and recommends that those claims be checked carefully and then renumbered upon allowance. Applicant submits that canceling and re-entering a large number of dependent claims would cause undue confusion at this stage of prosecution and respectfully requests that the objection be withdrawn and that renumbering of the claims be postponed until allowance.

Claim 33 and claims depending therefrom are subject to a new matter rejection for reciting the step “changing the coloration of one or more parts of the coating layer by irradiating those parts of the coating layer *to the exclusion of the remainder of the coating.*” The phrase “*to the exclusion of the remainder of the coating*” is descriptive of the inherent function of the apparatus and method of the invention. As support, the Summary of the Invention describes that the preparation is obtained “by irradiating *part* of the film coating layer...” (page 9, lines 24 - 25). Figures 1a and 1b, and page 18, lines 1 – 17 of the specification further describe a manner of irradiating one half of the preparation while shielding the other half. Thus, the added language is merely a characterization of the inherent function of the invention and is not new matter. Applicant respectfully requests that the new matter rejection be withdrawn.

Referring now to the cited references, Hampton discloses a multi-colored tablet coated with a clear coating. The multi-coloration is achieved by combining a first powder material

containing a first coloring agent with a second powder material containing a second coloring agent. The two powders are compressed to form a solid tablet having a demarcation line between the first material and the second material (col. 4, line 3 to col. 5, line 20). The two-colored tablet is subsequently coated with a clear gelatin layer.

Hampton does not disclose or suggest the multi-colored continuous film coating layer as recited in both independent Claims 31 and 33. According to Hampton, the coloring agents are contained in the first and second powders used to make the body of the tablet rather than in a coating layer. In fact, Hampton's specific description of a clear coating layer teaches away from the recited multi-colored coating layer. Thus, Hampton fails to disclose or suggest the claimed preparation.

Criticality of the claimed coating layer is exhibited by the fact that the coloration of the recited coating layer is distinct from the underlying body of the preparation. The claimed preparation does not require the use of differently-colored powders as required by Hampton. Further, the color of the claimed preparation may be changed after construction of the preparation so that, for instance, coloration may be changed shortly or long after manufacture of the preparation, whereas the coloration of the Hampton tablet is not changeable after application of the clear coating. Still further, having the coloration within the coating layer rather than the body of the preparation allows intricate patterns, such as bar codes, to be easily created within the coating (page 18, lines 18 – 20). Hampton fails to provide a viable method of producing such intricate coloration patterns. Thus, the recited multi-colored coating layer provides several significant benefits over the colored powder tablet of Hampton.

The disclosure of Hoover fails to cure the deficiencies of Hampton. Hoover discloses a cylindrically shaped caplet that is inserted into the body of the differently-colored gelatin capsule to give the appearance of a bi-colored capsule (col. 5, lines 17-19 and 54 - 59). Hoover provides no disclosure or suggestion of the recited multi-colored continuous film layer. Thus, Hoover, considered alone or in combination with Hampton, fails to disclose or suggest the claimed preparation.

In view of the remarks made above, Applicant submits that pending Claims 6 through 9, 11, and 13 through 20, and 31 through 47 are now in condition for allowance. Applicant

Appl. No.: 09/842,466
Amdt. dated 12/07/2004
Reply to Office action of September 22, 2004

respectfully requests that the claims be allowed to issue. If the Examiner wishes to discuss the application or the comments herein, the Examiner is urged to contact the undersigned by telephone.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

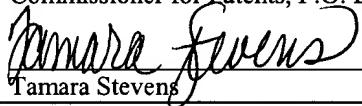


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